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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,257	02/18/2004	Tsuyoshi Nishiwaki	3.0-029C	2220

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EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/780,257	<b>Applicant(s)</b> NISHIWAKI ET AL.	
	<b>Examiner</b> Anthony Stashick	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 10 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 and 13 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 10/132,013.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Peterson 5,782,014. Peterson '014 discloses all the limitations of the claims including the following: (see especially Figure 4, alternate 14 for reference 12) a midsole 4 including a cushioning structure 10, the cushioning structure 10 provided between the outer sole and an upper (see Figure 1); a cushioning structure 10 comprising a thick column-shaped cushioning portion (14, alternate of 12); a plurality of grooves on an outer peripheral surface of the cushioning portion (see Figure 4); the respective grooves are helically formed around a substantially vertical axial line (see Figure 4); the respective grooves are arranged substantially parallel with each other (see Figure 4); a range in which each of the grooves is formed is larger than a range of 15 degrees around the axial line and smaller than a range of 180 degrees around an axial line (see Figure 4); a lead angle between the groove and a horizontal lane is set within a range of 35 degrees to 60 degrees (see Figure 4); a midsole body 4 defining a cavity 6c; a cushioning structure 10 fitted within the cavity; the cushioning structure comprises a column-shaped cushioning portion 12, 14.

### ***Claim Rejections - 35 USC § 103***

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being obvious over Peterson 5,782,014 as applied to claim 1 above. Peterson '014 as applied to claim 1 above discloses all the limitations of the claim except that outer peripheral surface of the cushioning member 14 being tapered. Peterson '014 teaches that the outer peripheral surface of 12 can be taper-shaped (i.e. truncate cone). Since cushion 14 is a replacement of 12, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to taper the outer peripheral surface of 14 as that of 12 to act independently with the modulator portion and provide stable distribution of forces over the regions which include the projections.

#### ***Allowable Subject Matter***

5. Claim 10 is allowed over the prior art of record.

6. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

7. Applicant's arguments filed September 2, 2005 have been fully considered but they are not totally persuasive. With respect to applicant's arguments directed to the Asics reference, the

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rejection using this reference has been withdrawn. With respect to applicant's arguments directed to Peterson '014, these arguments are not persuasive. Applicant argues that Peterson does not suggest the grooves being smaller than 180 degrees around the axial line and notes the use of the term "helical" in the description as support. It is noted that applicant claims the groove as follows "the respective grooves are helically formed around a substantially vertical axial line". Therefore, both the applicant's grooves and that of Peterson are "helically formed around a substantially vertical axial line" as required by the claim. Applicant further argues that the 180 degrees limitation is not met because the grooves of Peterson encircle greater than 180 degrees, like a screw and applicant's claims require "an encirclement less than 180 degrees" (see arguments, page 6 of 8, line 21). It appears applicant is arguing more than that which is claimed. The claims do not require that the "encirclement" be less than 180 degrees, only that the groove is formed between 15 and 180 degrees around the axial line. Therefore, taking an axial line in Figure 4 of Peterson, an angle of 15-180 degrees is held between the axial line and the groove anywhere around the axial line, thereby meeting this limitation in the claim. If applicant is meaning to require that the 15-180 degree limitation apply to "encircling" the axial line, then this limitation should be made clear in the claim. Applicant further argues that Peterson does not have the cushioning structure "fitted within the cavity of the midsole body" as required by claim 13. This is clearly shown in Peterson and pointed to specifically in the rejection of claim 13 above.

### ***Conclusion***

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8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

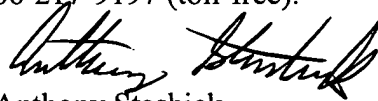
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS